

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

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| In re application of: | Cheryl L. Galante, et. al | Group Art Unit: 1617 |
| Serial No.: | 09/784,488 | Examiner: Layla Soroush |
| 10 Filed: | 02/15/2001 | Confirmation No.: 1716 |
| For: | PERSONAL CARE PRODUCT | Docket No.: 7144 |

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REPLY BRIEF PURSUANT TO 37 C.F.R. § 41.41

20 Board of Patent Appeals and Interferences
US Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

25 Sir:

Appellant hereby submits its Reply Brief in response to the Examiner's Answer
mailed February 4, 2009.

The Commissioner is hereby authorized to charge The Dial Corporation Deposit
30 Account No. 50-4219, \$540 for the filing of this Reply Brief.

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I. INTRODUCTION

This Reply Brief is submitted under 37 C.F.R. § 41.41 in response to Examiner's Answer mailed February 4, 2009. Each of the items required by 37 C.F.R. § 41.41 is
5 appropriately labeled and presented in this Reply Brief. Since Examiner's grounds of rejection were restated in Section (9) of Examiner's Answer, Appellant respectfully maintains all her prior arguments traversing Examiner's §102 rejection of Claims 1, 5, 7, 9, and 11 as being anticipated by Banowski et al. (U.S. 6,569,438), and traversing Examiner's §103 rejection of Claims 8, 13, 16, 20, 21, 61, 63, 66, and 67 as being
10 unpatentable over Banowski ('438) "as applied to Claims 1, 5, 7, 9, and 11 in view of Swaile" (U.S. 5,968,489). In addition, Appellant replies to each of the points made in Section (10) of Examiner's Answer.

II. TABLE OF AUTHORITIES

In re Hoeksema, 399 F.2d 269, (C.A.F.C. 1968), (cited at Page 9, Line 13 of this Reply Brief).

III. STATEMENT OF TIMELINESS

In accordance with 37 C.F.R. 41.41, Appellant has filed this Reply Brief to Examiner's answer within two months from the mail date of Examiner's Answer, February 4, 2009. Therefore, Appellant's Reply Brief is timely filed.

IV. STATEMENT OF ADDITIONAL FACTS

1. **Table 1:** The hydrophilic ingredients used in the examples of Banowski ('438) along with a total of these ingredients for each formula, (extracted from '438, "Examples", Col 5-10). Table is referenced in Appellant's argument, page 7, Lines 13-24.

| Banowski's Examples | Major Hydrophilic Ingredients (in weight %) | | | | |
|---------------------|---|-------|----------|-------|--|
| | Ethanol | Diol* | Polyol** | Water | Total hydrophilic materials in Banowski's hydrophilic gels |
| K1 | 56.80 | 29.17 | 2.60 | 2.15 | 90.72 |
| K2 | 0 | 30.00 | 46.00 | 4.10 | 80.10 |
| K3 | 30.00 | 26.01 | 26.40 | 0 | 82.41 |
| K4 | 45.00 | 39.40 | 3.00 | 0 | 84.40 |
| K5 | 45.00 | 35.40 | 3.00 | 5.00 | 88.40 |
| K6 | 40.00 | 45.40 | 3.00 | 0 | 88.40 |
| K7 | 50.00 | 25.40 | 3.00 | 10.00 | 88.40 |
| K8 | 40.00 | 45.40 | 3.00 | 0 | 88.40 |
| K9 | 22.70 | 52.91 | 0 | 0 | 75.61 |
| K10 | 50.00 | 34.10 | 3.00 | 0 | 87.10 |
| K11 | 30.00 | 57.75 | 3.00 | 0 | 90.75 |
| K12 | 50.00 | 37.95 | 3.00 | 0 | 90.95 |
| K13 | 50.00 | 37.95 | 3.00 | 0 | 90.95 |
| K14 | 40.00 | 46.95 | 3.00 | 0 | 89.95 |
| K15 | 40.00 | 49.95 | 0 | 0 | 89.95 |
| K16 | 22.70 | 51.40 | 0 | 9.70 | 99.80 |
| K17 | 0 | 47.83 | 0 | 38.50 | 86.33 |
| K18 | 0 | 47.65 | 0 | 39.80 | 87.45 |
| K19 | 0 | 46.70 | 0 | 35.49 | 82.19 |
| H1 | 56.90 | 29.17 | 2.60 | 2.15 | 90.82 |
| H2 | 0 | 30.00 | 46.00 | 4.38 | 80.38 |
| H3 | 30.00 | 26.51 | 26.40 | 0 | 82.91 |
| H4 | 45.00 | 41.60 | 3.00 | 0 | 89.60 |
| H5 | 22.70 | 53.71 | 0 | 9.70 | 86.11 |
| H6 | 50.00 | 34.90 | 3.00 | 0 | 87.90 |
| H7 | 45.00 | 36.60 | 3.00 | 5.00 | 89.60 |
| H8 | 40.00 | 46.60 | 3.00 | 0 | 89.60 |
| H9 | 50.00 | 26.60 | 3.00 | 10.00 | 89.60 |
| H10 | 40.00 | 46.60 | 3.00 | 0 | 89.60 |
| H11 | 30.00 | 60.25 | 3.00 | 0 | 93.25 |
| H12 | 50.00 | 40.45 | 3.00 | 0 | 93.45 |
| H13 | 50.00 | 40.45 | 3.00 | 0 | 93.45 |
| H14 | 40.00 | 49.45 | 3.00 | 0 | 92.45 |
| H15 | 40.00 | 52.45 | 0 | 0 | 92.45 |

* 1,2-propylene glycol and/or 1,3-butylene glycol and/or PEG; ** glycerin.

VIII. ARGUMENTS

Generally speaking, and as background, Appellant's invention is an underarm antiperspirant product comprising a dispensing container having a composition cast therein, where the composition has physically distinct, molded portions, and where each of the portions minimally includes at least one volatile silicone, a wax, or both. Appellant's physically distinct portions are hydrophobic in nature and easily re-melted. As such, Appellant's portions need to be molded into the container using Appellant's proprietary process described in the now issued U.S. Patent No. 6,838,032 in order to arrive at the claimed invention.

A. A prima facie case of anticipation has not been established because Banowski fails to point out each element of Appellant's invention:

Examiner states in Examiner's Answer that "a prima facie case of anticipation has been established". Appellant disagrees.

Much of the disagreement between the Examiner and the Appellant comes from the liberal use of synonyms in the art to describe the chemical "makeup" of a composition. Both in the prior art, and in Appellant's application, the gelled or molded compositions have been referred to as "phase", "vehicle", or "matrix". These terms have been used interchangeably, and each has been modified with the prefix "hydrophobic" or "hydrophilic". For example, if a hypothetical composition is comprised of a mixture of 30% water, 30% ethanol, 30% propylene glycol, 5% active materials and 5% of a gelling agent to solidify the mixture, a chemist will call that gelled mixture "hydrophilic", and will make reference to it as being "5% actives in a hydrophilic vehicle", or "5% actives in

a hydrophilic phase”, or “5% actives in a hydrophilic matrix”, or “5% actives in a hydrophilic portion”, or “5% actives in a hydrophilic gel”. The point Appellant wishes to make is that a chemist will set his/her “direction” for a formulation, and add compatible ingredients to the formula to maintain that direction. A chemist who sets the direction for a composition to be “hydrophilic” is not going to begin adding in hydrophobic materials (e.g. silicones, waxes, hydrocarbons, fats, etc.) to any great extent because they will create instability. What Examiner fails to acknowledge is that formulators work along strategic directions. Not all ingredients in the formulator’s universe are rationally interchangeable. Appellant has set the direction of her compositions to be hydrophobic.
10 With that direction set, Appellant uses hydrophobic materials to create an overall hydrophobic vehicle by incorporating high levels of silicones, waxes, fats, and the like, to yield a “waxy”, easily re-melted solid mixture. Banowski, on the other hand, has set his direction to be hydrophilic, and necessarily incorporates high levels of water, alcohols, diols, polyols, and the like to create his gelled matrices. With his direction set, it is
15 nonsensical to think that the examples of Banowski anticipate adding sufficient hydrophobic materials (silicones, fats, waxes, and the like) to turn a hydrophilic gel into Appellant’s hydrophobic wax. These strategies are distinct, incompatible, and mutually exclusive.

With that lecture said, Appellant reiterates her argument that Claims 1, 5, 7, 9 and
20 11 are patentable because each element of Appellant’s claimed invention, recited in Claims 1, 5, 7, 9 and 11, is not described or patented in Banowski.

Appellant’s Claim 1 reads: A product for underarm application, the product including an application surface that contacts the underarm during use of the product, the product comprising: a container; and, a first product portion having a first composition

and a second product portion having a second composition . . . wherein both the first composition and the second composition comprise an antiperspirant salt suspended in an anhydrous, hydrophobic vehicle including one or both of a volatile silicone and a wax having a melting temperature of at least 70 degrees C, and both the first composition and
5 the second composition form part of the application surface. Banowski does not teach that each separate portion of the composition be an anhydrous, hydrophobic vehicle. Indeed, Banowski only teaches use of very high total levels of hydrophilic materials including water, ethanol, diols, and/or polyols in various combinations.

Examiner believes the examples of Banowski contain antiperspirant suspended in
10 both hydrophobic and hydrophilic vehicles, hence meeting the limitation “suspended in a hydrophobic vehicle”. Appellant disagrees. Examiner’s statement is incorrect, and it shows that the examples of Banowski were either not read carefully or not understood by the Examiner. To make her point, Appellant has gathered the hydrophilic ingredients and their amounts found in each of the examples of Banowski and placed these data in **Table**
15 **1** of the “Statement of Additional Facts” section of this Reply Brief. Appellant’s **Table 1** shows the weight percent (wt %) of each of the hydrophilic materials used in each of the examples of Banowski to show that Banowski does not claim or teach making the hydrophobic vehicle of Appellant. **Table 1** also shows the total amount of hydrophilic materials incorporated in each of the Banowski examples. It can be seen that the total
20 hydrophilic material in each formula ranges from 75.61% up to 99.80%, with most well into 80’s-90’s percent. It is clear from **Table 1** that Examiner’s assertion that Banowski has formulas suspended in both hydrophobic and hydrophilic vehicles is simply wrong. None of the Banowski examples are formulated to be hydrophobic. They are all hydrophilic gels.

Appellant on the other hand uses hydrophobic phases comprised of hydrophobic silicones and/or waxes. Regardless if Banowski includes anhydrous examples (and Appellant agrees that about half of the Banowski examples do not include water), his examples are still overwhelmingly hydrophilic (75.61 - 99.80%), and they do not recite or
5 anticipate each element of Appellant's claimed invention. Furthermore, Appellant is not required to "disclaim" the universe of personal care formulary ingredients, as Appellant gleaned from Examiner's comment that Appellant's "claim in the instant invention is open-ended and does not exclude additional, unrecited elements". This assertion implies a requirement in claim drafting that is not only nonsensical, it is largely nonexistent.

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B. Examiner's statement that the claimed composition "does not require silicone" is misplaced *Banowski et al* (WO 99/23998; US 6,569,438) and *Swaile* (US 5,968,489) do not enable a person of ordinary skill to make Appellant's invention.:

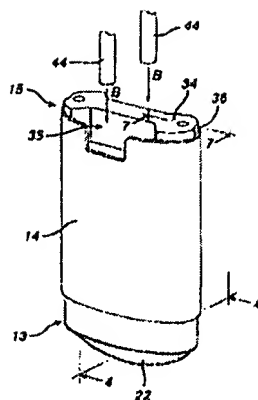
15 Appellant maintains that Banowski et al, (WO 99/23998; US 6,569,438), and Swaile et al, (US 5,968,489), do not qualify as enabling prior art (combined or otherwise) and thus do not render obvious Appellant's pending independent Claims 1, 9, and 16, or dependent Claims 5, 7, 8, 11, 13, 20, 21, 61, 63, 66, and 67. To traverse this continued obviousness rejection, Appellant has consistently maintained that it is not obvious to take
20 Banowski's hydrophilic gel compositions and simply substitute in silicones, waxes or any other hydrophobic materials described in Swaile to arrive at Appellant's invention, because Appellant's invention is made using Appellant's proprietary method disclosed in the now issued U.S. Patent No. 6,838,032 (filed by Appellant on the same day as this application under appeal).

PTO Docket No.: PTO-P-2007-0031. ("Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in KSR International Co. v. Teleflex Inc."), Section V states, "Office Personnel should consider all rebuttal evidence that is timely presented by the Appellants when reevaluating any obviousness determination", including for example, in the case of a claim to a combination the argument that, (1) *"one of ordinary skill in the art could not have combined the claimed elements by known methods (e.g., due to technological difficulties)"*, (emphasis added). Thus, when a prima facie case of obviousness is deemed made on similarity to a known composition, rebuttal may take the form of evidence that the prior art does not enable the claimed subject matter. "The absence of a known or obvious process for making the claimed compounds overcomes a presumption that the compounds are obvious, based on close relationships between their structures and those of prior art compounds", *In re Hoeksema*, 399 F.2d 269, 274 (C.A.F.C. 1968). Appellant argues that it is not obvious to make an antiperspirant product having side-by-side anhydrous hydrophobic portions containing silicones and/or waxes because the prior art does not teach, nor had access to, Appellant's proprietary method of manufacturing (now described in U.S. 6,838,032), which is required to make Appellant's invention.

The Examiner unfortunately reads Appellant's arguments so literally that Examiner was compelled to state; "the argument that it is not obvious to alter Banowski's composition into a high silicone composition is not persuasive". Appellant made the point in the Appeal Brief that it is not obvious to alter a hydrophilic composition into a hydrophobic composition by substituting ingredients in and out in random fashion. Examiner latched onto Appellant's use of "silicone" as an example hydrophobic ingredient to come up with the assertion that "the claimed invention does not require

silicone as argued by Appellant”, and therefore “the argument that it is not obvious to alter Banowski’s composition into a high silicone composition is not persuasive”. This is not the point. Banowski used gelled hydrophilic compositions and molded them sequentially in a container. It is not obvious for Banowski to convert his hydrophilic gels
5 into Appellant’s hydrophobic compositions by extensively lowering or removing his water, alcohol, diols, and/or polyols, and substituting in silicones and/or waxes. Even if Banowski radically decided gelled hydrophilic compositions were suddenly not desirable, and he stripped out his large amounts of hydrophilic materials and substituted in silicone, waxes or other hydrophobic substances, Banowski would not have been able to follow his
10 disclosed methodology to cast his newly found compositions stepwise and side-by-side in a container without the second casting re-melting the prior solidified portion.

Recall that both Banowski’s and Appellant’s inventions are essentially multiple-portion underarm antiperspirant compositions cast within their dispensing containers. Appellant’s portions are hydrophobic and comprise silicone, a wax, or both, and are
15 easily re-melted. That being said, Appellant’s portions need to be cast into the dispensing container using the method described in U.S. 6,838,032, wherein metal dividers are inserted down into the container and the two (or more) portions are injected into the recesses formed between the dividers and bounded by the container. The metal dividers are cooled and pulled out of the container, leaving behind a multi-portion product where
20 stripes or cores are positioned side by side within the container, (see **FIGURE** below, from Appellant’s ‘032 patent):



Banowski, on the other hand, (in '438 at Column 4, Line 60 through Column 5, Line 13), describes two methods for preparing a two-portion antiperspirant product. According to the first method, a core is produced by pouring a hot hydrophilic liquid phase containing a gellant into a mold and allowing it to cool and gel. The core is then placed inside a wider mold, and then a second hot hydrophilic liquid with gelling agent is then poured into the space inside the mold that surround the core. The second hot liquid is then cooled and gelled to form a shell that surrounds the core. According to Banowski's second method, the shell portion is prepared first by casting the heated liquid in an annular mold with a removable cylindrical core piece. After the shell cools and forms a gel, the core piece is removed. The second hot liquid is then poured into the cylindrical cavity of the shell, and is thereafter allowed to cool and gel. Had Banowski thought it obvious to incorporate high levels of hydrophobic materials and eliminate the hydrophilic materials such as water, ethanol, diols and/or polyols, in order to convert his base compositions from hydrophilic to hydrophobic, either of the two methods used by Banowski would fail to produce a multi-portion product within a container. Appellant's

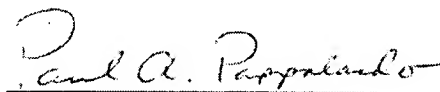
anhydrous, hydrophobic portions are too soft and too easily re-melted to allow any single portion to be cast first in the container and then used as partial support for the casting of the second portion. The hot melted second portion would necessarily melt the already cast first portion. As discussed, anhydrous, hydrophobic compositions that are easily re-
5 melted must be cast in a container having chilled divider blades inserted therein to provide the side-by-side recesses for the separate hot mixtures. The prior art references do not enable Appellant's invention. It was not obvious for Banowski to completely alter his highly hydrophilic gelled compositions into Appellant's anhydrous, hydrophobic compositions because the portions couldn't be molded sequentially as described by
10 Banowski.

IX. CONCLUSION OF ARGUMENTS

In view of the foregoing, Appellant reiterates that the rejection of Claims 1, 5, 7, 9, and 11 under 35 U.S.C. § 102, and rejection of Claims 8, 13, 16, 20, 21, 61, 63, 66, and 67 under 35 U.S.C. § 103 are improper and should not be sustained. Therefore, a reversal of the rejections repeated in Examiner's Answer dated February 4, 2009 is respectfully requested.

Respectfully submitted,

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XI. SUPPLEMENTAL APPENDIX

There is no supplemental materials relied upon by the Appellant in the present
Reply Brief.

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